

Karen Winner
Attorney at Law
233 Fifth Avenue, 4th Floor
New York, NY 10016
212-646-6334 fax: 212-213-3152

Date: January 27, 2010

US Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria VA 22313-1451

To the Trademark Trial and Appeal Board:

Enclosed with this cover letter is the following: an original and copy of NOTICE OF OPPOSITION TO REGISTRATION to oppose applicant/ serial number 77794272

Also enclosed is : 2) Proof of Service to Applicant Attorney,

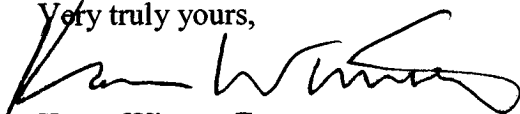
3) filing fee of \$300 to the Commissioner for Trademarks;

4) Verification of the undersigned;

5) self-addressed stamped envelope with first page of notice to serve as clocked-in receipt, sent via EXPRESS MAIL POST OFFICE TO ADDRESSEE.

I can be reached at the phone number listed above if there are questions or a need to discuss.

Very truly yours,



Karen Winner, Esq.
ATTORNEY FOR OPPOSER
ABE PUCHALL, HERALD SQUARE HOTEL

02/02/2010 SWILSON1 00000002 77794272

01 FC:6403

300.00 OP



01-27-2010

PROOF OF SERVICE

I, , do swear or declare that on this date January 27, 2010, as required on each party to the above proceeding or that party's counsel, and on every other person required to be served, by depositing an envelope containing the Notice of Opposition via EXPRESS MAIL POST OFFICE TO ADDRESSEE mail properly addressed to each of them.

The names and addresses of those served are as follows:

Neil Burstein, Esq.

ATTORNEY FOR APPLICANT

APPLE CORE HOTELS, INC. (US Patent/Trademark serial number 77794272)

Law Offices of Neil Burstein

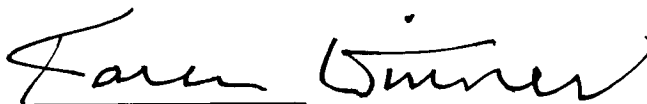
63 Winterberry Circle

Cross River, NY 10518-1311


914-977-3467

I declare under penalty of perjury that the foregoing is true and correct.

Executed on January 27, 2010



Karen Winner, Esq.
233 Fifth Avenue
New York, N.Y. 10016
646-633-4533

Sworn to me 1/27/10

MATTHEW MONROE
Notary Public: State of New York
No. 02MO6201584
Qualified in Kings County
Commission Expires March 2, 2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

NOTICE OF OPPOSITION

In the Matter of Trademark Application No.77794272
THE HOTEL @ HERALD SQUARE
Serial Number 77794272

Published in the Official Gazette on December 29, 2009

Herald Square Hotel Partners, LP, represented by agent Abraham Puchall
Opposers,

v.

Apple Core Hotels, Inc.

Applicant.

Opposition No.

To the Director of Patents and Trademarks:

Trademark Trial and Appeal Board:

Herald Square Hotel Partners, LP composed of a foreign limited partnership organized and existing under the laws of the State of Delaware, registered to do business as Herald Square Hotel in New York and having as its principal business address at 19 West 31st Street, New York, New York County, New York, 10001, (agent Abraham Puchall) believes that it will be damaged by registration of the service mark THE HOTEL @ HERALD SQUARE, U.S. Trademark Application Serial No77794272, and by this notice opposes the registration of the mark.

The application was filed July 31, 2009 and published for opposition in the Official Gazette of December 29, 2009. The applicant Apple Corp Hotels, Inc. is a New York corporation having its place of business at 15 West 39th Street, 15th Floor, New York, New York 10018, United States.

As grounds of opposition, it is alleged that:

1. Opposer and/or its predecessor have used the name Herald Square Hotel in connection with its hotel since at least 1985, on an ongoing and continuous basis, 365 days a year for at least 25 years.
2. Opposer and/or its predecessor have used the name, Herald Square Hotel and have sold hotel rooms at the Herald Square Hotel in interstate commerce domestically, in foreign commerce, and in intrastate commerce since at least as early as 1985, and have built up a large investment so that the name now has a great value. The prior use has distinguished opposer's services and opposer's predecessor's services since long prior to July, 31, 2009, the date of applicant's service mark application, which has not been in use and was filed under a 1 B basis (intent to use).
3. Over the years, opposer has supplied rooms to more than a quarter of a million domestic and international hotel guests at the Herald Square Hotel under the name "Herald Square Hotel" at its location at 19 West 31st Street, New York, N.Y.. The Herald Square Hotel by its name is generally known to the public nationwide through numerous published articles appearing in the mainstream press. See *New York Magazine* article published on the date of June 3, 1991, annexed herein as Exhibit "A." See *Chicago Tribune* article published on date of September 9, 1990, "Cheap Chic to Core of the Big Apple" annexed herein as Exhibit "B". Opposer and its predecessor have since 1985 sold, and continue to sell hotel rooms through the name "Herald Square Hotel." Additionally, opposer and its predecessor have advertised extensively in print media in the United States and in publications aimed directly at United States tourists and foreign tourists visiting New York, and opposer is continuing to do so. Consequently, at no time

has opposer or its predecessor intended not to use the name Herald Square Hotel for its hotel.

4. Opposer's name "Herald Square Hotel " and applicant's alleged mark "The Hotel @ Herald Square " are nearly identical in every regard, namely, in appearance, sound, and connotation, and are likely to cause confusion or mistake, or to deceive customers, all to the damage of opposer and the good will of its business.

5. On information and belief, applicant Apple Core Hotels, Inc. intends to use its alleged pending mark for a hospitality service to advertise a group of competing hotels and motels it owns in the same general geographic vicinity as opposer's Herald Square Hotel. The hotel services of the respective parties are similar and are likely to be sold to the same purchasers. Applicant's intended use of opposer's name will likely create confusion between names because of applicant's own competing group of hotels located in the same geographical district –within a few blocks of opposer's The Herald Square Hotel.

6. The alleged name and mark of applicant is confusingly similar to the opposer's hotel name and the services to which the alleged mark of applicant is applied are confusingly similar to the services of opposer. Opposer uses the name Herald Square Hotel and it is likely that the alleged mark of applicant when applied to the services of applicant would cause confusion, mistakes, and deception of purchasers, all to the damage of opposer.

7. The opposer's name, Herald Square Hotel, has gained major distinction through the years, because of the historic architectural fame of the building and its architects Carrère and Hastings, and the building is uniquely recognizable through its name Herald

Square Hotel. See: http://en.wikipedia.org/wiki/Carr%C3%A8re_and_Hastings. Also see *The New York Sun* newspaper article dated May 24, 2007, "Life Magazine Lives at Herald Square Hotel" annexed herein as "Exhibit C".

8. Opposer will be damaged by registration of the alleged mark of applicant, which registration would represent the prima facie exclusive right to use the name "The Hotel @ Herald Square" by applicant, all to the damage of the opposer. Opposer opposes both the use of the name The Hotel @ Herald Square and the proposed stylized mark.

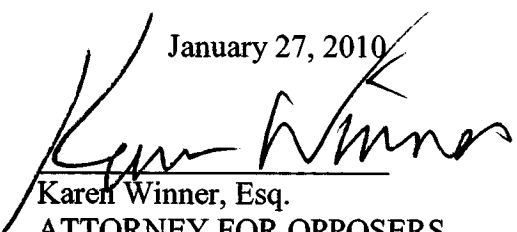
9. In the Declaration by applicant's attorney declared on July 31, 2009, under penalty of perjury he declared that he believed "no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form other of or in such near resemblance thereto as to be likely, when used on or in connection with the services of such other person, to cause confusion or to cause mistake, or to deceive and that all statements made of his own knowledge are true, and on information and belief, are believed to be true." Notwithstanding this Declaration, Applicant Apple Core Inc. and/or its agents have had both actual and constructive knowledge of opposer's longtime prior use of name Herald Square Hotel, since Herald Square Hotel has been subject of numerous mainstream press articles and since respective parties have memberships in Hotel Association of NYC Inc. and have, on information and belief, communicated with each other about their respective hotels. Also, the name -- Herald Square Hotel -- is listed on the membership roster page for public view, available at <http://www.hanyc.org/RosterPage/hotelroster1.htm#A>.

Additionally, for several years, Herald Square Hotel has maintained its own website available for public view and easily located through search engines. See Exhibit "D" annexed herein.

For the foregoing reasons, the U. S Patent and Trademark Office should not grant use of the name or mark "The Hotel @ Herald Square" to applicant.

Dated: New York, New York

January 27, 2010



Karen Winner, Esq.

ATTORNEY FOR OPPOSERS
HERALD SQUARE HOTEL PARTNERS LP
233 Fifth Avenue, 4th Floor
New York, N.Y. 10016
646-633-4533

TO: Neil Burstein, Esq.
ATTORNEY FOR APPLICANT APPLE CORE HOTELS, INC>
63 Winterberry Circle
Cross River, New York 10518
914-977-3467

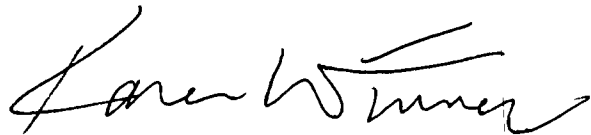
VERIFICATION

STATE OF NEW YORK :
SS.:
COUNTY OF NEW YORK :

KAREN F. WINNER, being duly sworn, deposes and says:

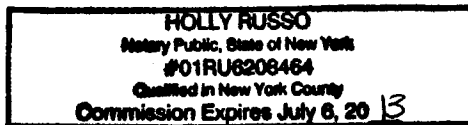
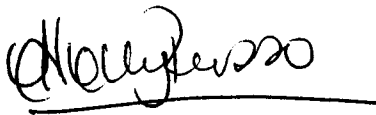
That she is the attorney for Opposer Abe Puchall in the captioned action Notice of Opposition, with offices located at 233 Fifth Avenue, 4th Floor, New York, County of New York, State of New York, that she has read the foregoing Notice Of Opposition to Registration and knows the contents thereof; that the same is true to the best of her own knowledge, information and belief.

Deponent further says that the grounds of her belief as to all matters in the Notice of Opposition not stated to be upon her knowledge are based upon a review of public documents and discussions with the Opposer.



Karen Winner, Esq.
233 Fifth Avenue, 4th Floor
New York, NY 10016

Sworn to me this 26th day
of January, 2010



NEW YORK

FOR A FEW DOLLARS LESS
(UNDER \$100 A NIGHT)

IN A NICHE OVER THE DOORWAY OF A Beaux-Arts building on 31st Street sits a chubby cherub—Philip Martiny's sculpture *Winged Life*. The building, designed by John Mervin Carrère and Thomas Hastings (whose other works include the New York Public Library), was home to both Charles Dana Gibson and the original *Life* (a humor magazine).

Now it's home to the Herald Square Hotel (19 West 31st Street; 279-4017). Sleep comes very cheap in this immaculate, freshly spruced-up inn. Just don't send your friends there hungry: At night, when the department stores are closed, there are few places to eat, except for O'Reilly's Pub and Restaurant and a sprinkling of fast-food joints and coffee shops. And, since the loft and commercial buildings in this neighborhood shut down about five, this area is dark and bleak at night; your guests won't want to be roaming around.

My single room (long and narrow—about thirteen and a half feet long by six feet wide) had a tiny window, champagne-colored walls, and a TV set, a desk, a chair, and a firm, comfortable platform

modern bathroom was large for a room of this size.

The hotel's hallways are bright and gleamingly clean—pale-rose floor tiles, sponge-painted pink and blue walls showcasing framed covers of the original *Life*. The lobby—small and unfurnished—glows in tones of cream and pink. Many of the guests, the manager says, are middle-aged women from Venezuela; every two or three weeks, like clockwork, they fly up on buying trips, load up with handbags, jewelry, and other accessories, and fly home to sell them at their boutiques in Caracas. When I was checking out, some young backpackers with German accents were setting off for further adventures.

Through the end of the year, a single room with shared bath is \$40. A room with private bath is \$50 and \$65, single; \$55 to \$85, double; \$90, triple occupancy; and \$95, quadruple occupancy.

CHEAP SLEEP

INDING A MODEST-PRICED HOTEL ROOM IN NEW YORK BY VINCENT FRONTERO

EXHIBIT "A"
PRESENTED BY OPPOSERS -- New York Magazine,

NOTICE OF OPPOSITION TO MARK (AND NAME)
"THE HOTEL@HERALD SQUARE

HERALD SQUARE HOTEL PARTNERS, LP

APPLE CORE HOTELS, INC
SERIAL NO 77794272

Exhibit A

Travel

Chicago Tribune Sunday, September 9, 1990

Cheap chic to core of the Big Apple

By Lisa Anderson
Chicago Tribune

New York—They could go home with Playbills from a few terrific Broadway shows, the taste of some fabulous meals and some glossy shopping bags filled with wearable memories, but most Manhattan visitors leave this island having invested the bulk of their vacation budget in a hotel room, where they spent most of the time asleep in bed.

This need not be the case. In a city where some hotels cheerfully charge \$5-plus for a glass of room service orange juice and double rooms starting at \$160 are considered "moderate," the General Services Administration allows government employees \$147 per day to cover meals and lodging in New York. With this figure in

Although unfurnished, the pink and cream-colored lobby, with its *trompe l'oeil* "rug" of tiles and reception desk sealed behind glass, avoids the police station severity of some small hotels. Adjacent to the lobby is a waiting room with seating, a bath with shower and lockers for guests who have checked out but want to store their luggage or freshen up before departure.

Although not as cozy as the Pickwick in atmosphere or neighborhood, the Herald Square takes a functional approach that is spare, but tasteful. Rooms, which feature platform beds and formica furnishings, are done in tones of cream and hunter green. New bathrooms sparkle. Although uncarpeted, the well-lit hallways are pleasant, with rose tile floors and a soft mottled pink and gray wall treatment. There is no room service at the Herald Square, but the hotel provides a list of nearby coffee shops and restaurants which deliver.

Room prices at the Herald Square start at \$35 for a single, sharing a hallway bathroom with one other room on the floor. A small single with a private bathroom with shower only is \$50, while a standard single with full bath is \$60. Doubles start at \$65, going up to \$95 for a large double that can sleep four people. For reservations, 800-727-1888.

This family-owned group also operates two other similar hotels, the Portland Square Hotel, 132 W. 47th St., 800-388-8988, priced similarly to the Herald Square Hotel, and the Washington Square Hotel, 103 Waverly Place, 800-222-0418, in Greenwich Village, where all rooms, with bath, are \$80.

Herald Square Hotel

Another well-priced find is the newly-refurbished Herald Square Hotel at 19 W. 31st St., between Fifth Avenue and Broadway. Deliberately budget-priced, this family-owned hotel is popular with vacationing European students, but is well-suited to anyone who is looking for an immaculately-clean hotel at rock-bottom prices.

The Herald Square area, which is home to Macy's, a new Abraham & Straus department store and Herald Center, a vertical shopping center, has long been a center of so-called budget hotels. Predominantly commercial, it tends to be rather desolate at night. Although one should still exercise caution after dark, the neighborhood is steadily improving and its central location and proximity to shopping, theaters and public transportation are factors in its favor.

The 114-room hotel, with its wrought-iron and glass canopy and buff facade, occupies the 1893-vintage building erected as the headquarters for the original Life Magazine, whose emblematic cherubim is sculpted over the entrance. The hotel's connection to Life, and to artist Charles Dana Gibson, of Gibson Girl fame, who once was a resident, is lovingly celebrated by the hotel's history buff manager, Abraham Puchall, who has decorated the lobby, rooms and

Exhibit "B"
PRESENTED BY OPPOSERS
Chicago Tribune, Travel Section:
"Cheap chic to core of the Big Apple -- September 9, 1990

HERALD SQUARE HOTEL PARTNERS, LP
v.
APPLE CORE HOTELS, INC

NOTICE OF OPPOSITION TO MARK (AND NAME)
THE HOTEL@HERALD SQUARE
FRIAL NO 77794272

Exhibit B



NEIGHBORHOODS

Life Magazine Lives at Herald Square Hotel

By **GABRIELLE BIRKNER**
Staff Reporter of the Sun

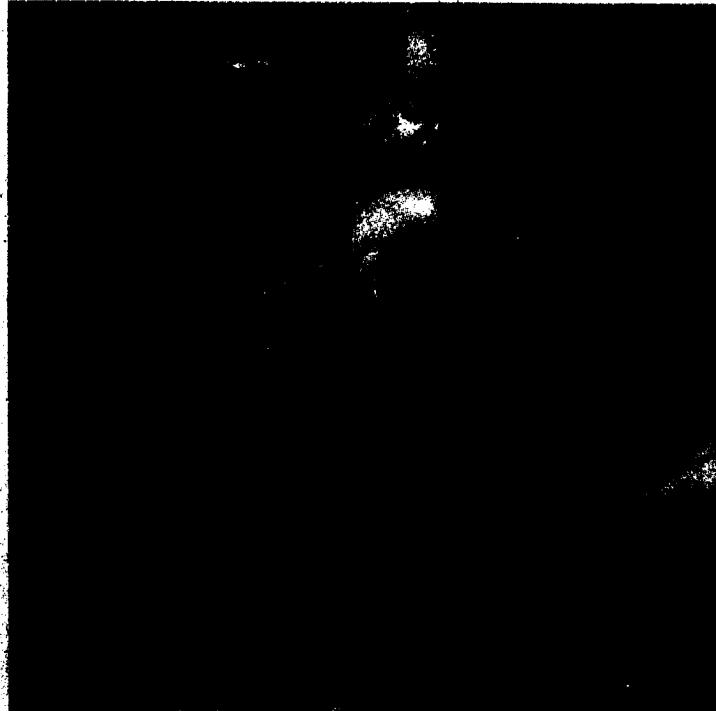
In a city full of brand name hotels, the Herald Square Hotel West 31st Street is neither a chain nor a franchise. It is privately owned by Abraham Puchall, a German shepherd breeder who said he senses a psychic link with *Life's* founding editor, John Ames Mitchell.

"There's some kind of weird connection," Mr. Puchall, 52, said.

Life Magazine, in its heady, early days, was full of social satire and original illustrations — bearing little resemblance to the picture book it became, or to the now-defunct newspaper supplement that followed.

Today, Mr. Puchall's hotel serves as an ode to that early incarnation of *Life*, which was housed in that very Beaux-Arts building between 1894 and 1936. The walls of the hotel are covered with magazine memorabilia: original artwork by *Life* illustrators including Charles Dana Gibson, replicas of witty cover drawings, and old advertisements, such as an undated one, boasting escorts to serve as "mourners or pallbearers at fashionable funerals."

About five years ago, Mr. Puchall went so far as to buy Mitchell's old house in Ridgefield, Conn. — a



'WINGED LIFE' Hoteller Abraham Puchall recently purchased this cherub given to *Life* magazine's editor, John Ames Mitchell, in 1894 for the lobby of his Herald Square Hotel on West 31st Street.

place that the hotelier swears he admired before he knew that about its former resident. And just recently, he purchased a bronze sculpture of a cherub that artist Philip Martiny gifted to Mitchell

in 1894. This statue, displayed in the hotel entryway, matches an ornament affixed to the building's façade, which is now covered by scaffolding.

The hotel's exterior, altered over

the years by construction erts, remains ornate; the i or, while spotless, is more m — its paint a little faded, an tiles mismatched. But wh lacks in coordination, it mak for in price. Depending on the son, the room rates range \$69 for a small single room v shared bathroom, to \$259 a vated double room, featurin low-top mattresses, private ble bathrooms, and flat-sc televisions — hundreds of d less than a room at many chains. About 40 of the 117 r have been renovated in re years, a hotel manager said.

The architectural duo be the New York Public Librai West 42nd Street, Carre Hastings, designed the bui in 1893. In later years, the b ing would become residentia tel, and then a tourist hotel.

The Puchall family purch the building in 1970. Since Mr. Puchall has been hirin searchers to look into the hist the building, the magazine housed in it, and that magaz editor. "We're trying to ma more and more like a museu said. One researcher, Na Charlsen has been studyin building, and its former tenan nearly two decades. "Every t think I'm coming to the end, th a new connection," she said.

Exhibit C

Exhibit "C"

PRESENTED BY OPPOSERS

The New York Sun, Real Estate Section:

"Life Magazine Lives at Herald Square Hotel"
published on May 24, 2007, page 13

HERALD SQUARE HOTEL PARTNERS, LP

v.

APPLE CORE HOTELS, INC

NOTICE OF OPPOSITION TO MARK (AND NAME)
"THE HOTEL@HERALD SQUARE"
SERIAL NO 77794272

A Boutique Hotel with Budget Prices!
Our New Rooms are
Three Star Rooms in a Two Star Hotel
ONLY with Direct Reservations

Please Click Here to Make Direct Reservations



Every room is unique and different at The *Herald Square Hotel* the size, shape,

layout and furniture change from floor to floor and it's location on that floor.

All rooms have Satellite TV with Free HBO, an in-room safe, voicemail messaging, air conditioning and High Speed WI-FI Internet access.

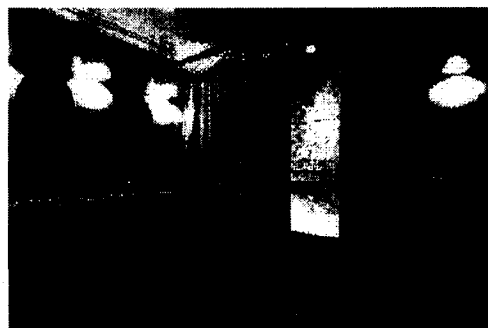
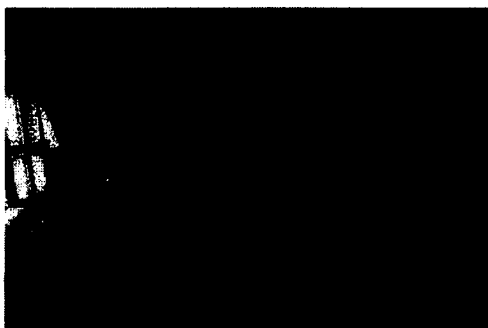
By Popular Demand, Changing Times and Good Health, *The Herald Square Hotel* is **TOTALLY SMOKE FREE**

New Deluxe 2 Queen Bedroom with a private bathroom

Up to Four People.

Amenities:

Turn of the century decor, 2 Queen size pillow top mattresses, 8 pillows, 2 comforters, LCD flat screen TV, FREE HBO, alarm clock radio with CD player, lighted make-up mirror, hair dryer, iron and ironing board. Complimentary in-room high speed wireless internet access, data port, in-room safe, voicemail service



New Large Queen Bedroom with a private bathroom

One or Two People.

Amenities:

Queen size mattress, 4 pillows, a comforter, TV with FREE HBO, Complimentary in-room high speed wireless internet access, data port, in-room safe, voicemail service.



EXHIBIT D
PRESENTED BY OPPOSERS
HERALD SQUARE HOTEL
WEBSITE <http://www.heraldsquarehotel.com/room.htm>
HERALD SQUARE HOTEL PARTNERS, LP

NOTICE OF OPPOSITION
TO MARK (AND NAME)
"THE HOTEL@HERALD SQUARE/ SERIAL NO 77794272

PROOF OF SERVICE

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Law Offices of Neil Burstein

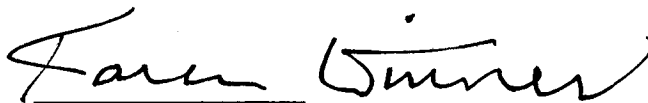
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Executed on January 27, 2010




Karen Winner, Esq.

233 Fifth Avenue

New York, N.Y. 10016

646-633-4533

Sworn to me 1/27/10

MATTHEW MONROE
Notary Public: State of New York
No. 02MO6201584
Qualified in Kings County
Commission Expires March 3, 2013